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APR 10 2007

**OFFICE OF PETITIONS**

In re Application of	:	
Imanishi et al.	:	DECISION ON APPLICATION
Application No. 10/054,300	:	FOR
Filed: January 22, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No. 01834CIP/HG	:	

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705)" filed February 2, 2007. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred seventy-three (473) days to one thousand one hundred nineteen (1119) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand thirty-three (1033) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 4, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term

adjustment (PTA) to date is 473 days. On February 2, 2007, applicants timely<sup>1</sup> submitted an application for patent term adjustment (with required fee). Applicants assert that the Office erred in entering a period of reduction of 646 days for applicant delay.

Applicants state that any patent granted on this application is not subject to a terminal disclaimer.

Applicants are correct that the reduction of 646 days is not warranted. A review of the application history confirms that applicants' complete response to the Notice to File Missing mailed March 25, 2002, was received in the Office on April 16, 2002. As such, the response was filed inside the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application mailed March 25, 2002.

However, this review also reveals a basis for entry of a period of reduction for applicant delay. As stated in MPEP 2732:

37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Submitting a reply having an omission requires the Office to issue an action under 37 CFR 1.135(c) and await and process the applicant's reply to the action under 37 CFR 1.135(c) before the initial reply (as corrected) can be treated on its merits. In addition, 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission

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<sup>1</sup> PALM records indicate that the Issue Fee payment was received on March 30, 2007.

which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

On January 6, 2004, at the request of the Office, applicants submitted a duplicate CRF of sequence listing<sup>2</sup>. By Notice mailed February 11, 2004, applicants were advised of omissions in this response. On April 1, 2004, applicants submitted a response correcting the omissions. Therein, applicants did not dispute the validity of the Office's assertion that there were omissions in their response. In addition, it is specifically noted that the Statement under 37 CFR 1.821 provided was signed March 18, 2004. Thus, it was not a duplicate from the earlier filing. This further supports a conclusion that there were omissions in applicants' response as originally filed April 16, 2002 (and resubmitted January 6, 2004). Thus, a period of reduction of 86 days for the period beginning on the day after the date the reply having an omission was filed, January 7, 2004, and ending on the date that the reply or other paper correcting the omission was filed, April 1, 2004 is properly entered.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one thousand thirty-three (1033) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

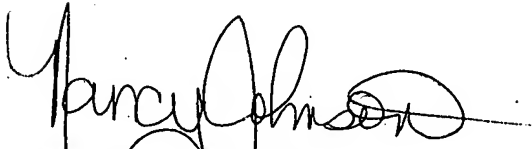
The Office of Patent Publication has been advised of this decision. The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment

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<sup>2</sup> As shown in the record of the application, applicants' original response filed April 16, 2002 was damaged in the mail (and thus, was not reviewed by the Office). Under the circumstances, it is appropriate to use the duplicate filed January 6, 2004 in ascertaining applicant delay pursuant to 1.704(c)(7).

of the issue fee and satisfaction of all outstanding requirements.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized flourish at the end.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

**PTA Calculations for Application: 10/054300**

Application Filing Date:	01/22/2002	PTO Delay (PTO):	1119
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	646
Post-Issue Petitions:	0	Total PTA (days):	1033
PTO Delay Adjustment:	560		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
65	04/09/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		86	
64	04/09/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	646		
57	01/04/2007	MAIL NOTICE OF ALLOWANCE			
56	12/26/2006	ISSUE REVISION COMPLETED			
55	12/26/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
54	12/26/2006	CASE DOCKETED TO EXAMINER IN GAU			
53	12/26/2006	NOTICE OF ALLOWABILITY			
52	09/22/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
51	09/22/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
50	09/22/2006	REFERENCE CAPTURE ON IDS			
49	09/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	47
48	09/29/2006	DATE FORWARDED TO EXAMINER			
47	09/22/2006	RESPONSE AFTER NON-FINAL ACTION			
46	06/27/2006	MAIL NON-FINAL REJECTION			
45	06/23/2006	NON-FINAL REJECTION			
44	04/01/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
43	03/09/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
42	04/19/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
41	05/01/2006	DATE FORWARDED TO EXAMINER			
40	04/26/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
39	04/14/2006	MAIL RESTRICTION REQUIREMENT	1119		-1

38	04/13/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
37	04/04/2006	CASE DOCKETED TO EXAMINER IN GAU			
36	11/23/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
35	04/22/2005	CORRESPONDENCE ADDRESS CHANGE			
34	10/20/2004	MISCELLANEOUS INCOMING LETTER			
33	04/01/2004	REFERENCE CAPTURE ON IDS			
32	04/01/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	03/09/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	07/17/2002	PRELIMINARY AMENDMENT			
29	04/24/2002	PRELIMINARY AMENDMENT			
28	04/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	08/30/2004	CASE DOCKETED TO EXAMINER IN GAU			
26	04/19/2002	REFERENCE CAPTURE ON IDS			
24	08/26/2004	CASE DOCKETED TO EXAMINER IN GAU			
23	07/27/2004	REFERENCE CAPTURE ON IDS			
22	05/10/2002	MISCELLANEOUS INCOMING LETTER			
21	04/24/2002	PRELIMINARY AMENDMENT			
19	04/15/2004	APPLICATION DISPATCHED FROM OIPE			
18	04/16/2004	APPLICATION IS NOW COMPLETE			
17	04/01/2004	ADDITIONAL APPLICATION FILING FEES		646	4
16	04/01/2004	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
15	04/01/2004	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
14	01/22/2002	CLAIM PRELIMINARY AMENDMENT			
13	04/14/2004	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
12	02/11/2004	SEQUENCE ERRORS			
9	04/16/2002	ADDITIONAL APPLICATION FILING FEES			
7	04/16/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
6	02/09/2004	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
5	04/11/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC			

		115, OATH OF THE APPLIC			
4	03/25/2002	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	03/08/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	02/05/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/22/2002	INITIAL EXAM TEAM NN			

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**EXPLANATION OF PTA CALCULATION**

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